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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/686,431	10/14/2003	Dale W. Malik	190250-1590	7278

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THOMAS, KAYDEN, HORSTEMEYER & RISLEY, LLP/
AT&T Delaware Intellectual Property, Inc.
600 GALLERIA PARKWAY, S.E.
SUITE 1500
ATLANTA, GA 30339-5994

EXAMINER

CHANG, JUNGWON

ART UNIT	PAPER NUMBER
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2154

MAIL DATE	DELIVERY MODE
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08/13/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/686,431	Applicant(s) MALIK ET AL.	
	Examiner JUNGWON CHANG	Art Unit 2154	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 and 22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 and 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/23/08, 7/23/08</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to RCE filed on 7/23/08. Claim 21 has been canceled, and claim 22 has been added. Claims 1-20 and 22 are presented for examination.

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/23/08 has been entered.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-19 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bernstein et al, (US 2004/0128356), hereinafter Bernstein, in view of Beyda (US 2003/0229670).

5. As to claims 1, 9 and 10, Bernstein discloses the invention as claimed, including

method comprising the steps of:

determining an Internet presence of a contact identified in an email message (page 2, 0016-0017, "presence detection by sending...email invitation"; page 1, 0007, "particular user's presence online...presence detection"); and

initiating, by the instant messaging client (instant messaging application) an instant messaging (IM) chat session with the contact in response to determining that the contact is present (page 1, 0007; page 4, 0064, "each recipient is sent an instant message invitation email message").

6. Although Bernstein discloses determining an internet presence of a contact, Bernstein does not specifically disclose the presence of the contact is determined by an instant messaging client. Beyda discloses the presence of the contact is determined by an instant messaging client (120, fig. 6; page 2, 0022, "user's online presence may still be detected or monitored by an instant messaging system"; 0029, "instant messaging server, service or system and thereby capable of detecting or monitoring the online presence"). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of Bernstein and Beyda because Beyda's teaching would allow a user to be notified of the presence of the intended recipient, as taught by Beyda (page 1, 0004-0005).

7. As to claims 2-8, Bernstein discloses, wherein the step of initiating the IM chat session comprises the steps of: generating an IM chat window; obtaining information

from the email message; and displaying the obtained information in the generated IM chat window (page 2, 0023, "IM area"; page 5, 0093-0100, "display to the user").

8. As to claims 11-13, they are rejected for the same reasons set forth in claims 2-8 above. In addition, Bernstein discloses computer-readable code (page 3, 0052-0053).

9. As to claim 14, it is rejected for the same reasons set forth in claim 1 above. In addition, Bernstein discloses computer-readable code (page 3, 0052-0053).

10. As to claims 15-19 and 22, they are rejected for the same reasons set forth in claims 1-8 above. In addition, Bernstein discloses computer-readable code (page 3, 0052-0053).

11. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bernstein et al, (US 2004/0128356), hereinafter Bernstein, in view of Beyda (US 2003/0229670), further in view of Dalal et al, (US 2002/0065894), hereinafter Dalal.

12. Bernstein discloses displaying the obtained information in the generated IM chat window (page 2, 0023, "IM area"; page 5, 0093-0100, "display to the user"). However, Bernstein does not specifically disclose providing the body of the email message as an IM chat message. Dalal discloses providing the body of the email message as an IM chat message (page 3, 0024, "the body of the email reply becomes the text content of

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the instant messaging"). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of Bernstein and Dalal because Dalal's teaching would reduce the time to generate an instant message which has correlation information with the email message, as taught by Dalal (page 3, 0024).

13. Applicant's arguments with respect to claims 1-20 and 22 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Karim, US 2003/0217108, Wick et al, US 2005/0030937 disclose method and system for providing an interactive dialog messaging session for electronic mail users.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JUNGWON CHANG whose telephone number is (571)272-3960. The examiner can normally be reached on M-F 6:30 - 2:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Flynn can be reached on 571-272-1915. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

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Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JUNGWON CHANG/
Primary Examiner, Art Unit 2154
August 4, 2008